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EXAMINER

PATEL, DHIRUBHAI R

ART UNIT PAPER NUMBER

2831

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,572

Applicant(s)

ACKERMAN ET AL.

Examiner

DHIRU R. PATEL

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-27, 37, 38 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-27, 37, 38 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2831

Part III DETAILED ACTION

1. The finality of the final rejection mailed on 9/22/2004 is hereby vacated to clarify the rejections to claims 23-27, 37-38 and 40. This office action replaces previously office action sent on 9/22/04 with a new statutory period. Any inconvenience to the Applicant is regretted.
2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the 6,521,834 reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The applicant has failed to provide the following with respect to Declaration, Exhibits A through E :

For claim 23: a method of assisting a compromised barrier comprising : placing the fire retardant gasket between a faceplate and an electrical box, coupling the faceplate to the box, and at least partially reestablishing a fire rating of the barrier.

For claim 37, a method of assisting a compromised barrier comprising: installing into a fire rated barrier an electrical box, introducing into the electrical box a fire retardant gasket, and covering the electrical box with a faceplate .

It is noted that a declaration does not provide the claimed subject matter for claims 23 and 37. Exhibit A for E -mail and discussed about "gasket" for cover plates, but did not provide any information about a gasket comprising fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite as claimed in claim 23 and 37,

Art Unit: 2831

Exhibit B discussed about an electrical box only, but did not provide placing the fire retardant gasket between a faceplate and an electrical box for claim 23 .Exhibit C discussed about metal size only, and Exhibit D discussed about a plate , a box, hole and cold face, but did not provide claimed subject matter for claims 23 and 37, and Exhibit E testing of 1.5mm blazeseal electrical plate covers only. Exhibits A through E are insufficient to establish a conception of the invention prior to the effective date of the 6,521,834 reference.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 23-27 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 23 line 8, “ at least partially reestablishing a fire rating of the barrier” is confusing and unclear in light of the specification. What is at least partially reestablishing a fire rating of the barrier?.

Art Unit: 2831

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C.102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 23-27, 37-38, 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Dykhoff et al (6,521,834).

Assembly of the device of Dykhoff et al comprises a method steps of:

Regarding claim 23, as best understood, a method of assisting a compromised barrier 4 (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-35, column 2 lines 40-46, column 3 lines 40-50, column 4 lines 30-40, column 14 lines 45-55) comprising:

a) providing a gasket 8 (a fire stopping mat, see fig 1, column 2 lines 10-64, column 3 lines 40-50, column 4 lines 30-45) comprising fire retardant material of a fire resistant insulative material (i.e. a binder, see column 7 lines 57-67,

Art Unit: 2831

column 9 lines 23-30, column 11 lines 24-67, column 12 lines 1- 24) containing **an intumescent graphite** (see abstract lines 11-14, column 9 lines 3- 30, please note that the fire stopping mat include an intumescent compound);

b) placing the fire retardant gasket 8 between a faceplate 6 and an electrical box 10 (see fig 1, column 2 lines 10-25, column 3 lines 40-45, see column 4 lines 30-53, column 14 lines 38-55) adapted to be introduced into the barrier 4 (see fig 1, column 3 lines 20-50, column 4 lines 30-60, column 14 lines 45-52);

c) coupling the faceplate 6 to the box 10 (see fig 1 , column 3 lines 40-50, column 4 lines 30-54, column 15 lines 1-5) ;

and d) at least partially reestablishing a fire rating of the barrier (see column 1 lines 15-35, column 2 lines 20-26, column 3 lines 5-50, column 4 lines 54-62, column 14 lines 45-52).

Regarding claim 24 , as best understood, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including further comprising coupling the gasket 8 in situ between the faceplate 6 and the box 10 (see fig1, column 3 lines 30-50, column 4 lines 30-62, column 16 lines 10-16).

Regarding claim 25 , as best understood, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including providing the gasket 8 comprises forming the gasket 8 as a separate element (see fig 1, column 3 lines 40-50, column 4 lines 35-40, column 16 lines 10-16) prior to

Art Unit: 2831

placing the gasket 8 between the faceplate 6 and the box 10 (see fig1, column 4 lines 30-50 and column 16 lines 10-16).

Regarding claim 26 , as best understood, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including further comprising forming the gasket 8 on one surface of the faceplate 6 prior to coupling the faceplate 6 to the box 10 (see column 3 lines 40-50, column 4 lines 54-62, column 16 lines 10-16).

Regarding claim 27, as best understood, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the gasket is being formed by establishing a coating of the fire retardant material onto the faceplate 6 (see column 2 lines 29-35, column 3 lines 40-45, column 15 lines 1-14).

Assembly of the device of Dykhoff et al comprises a method steps of:

Regarding claim 37, a method of assisting a compromised barrier (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-35, column 2 lines 40-46, column 3 lines 40-50, column 4 lines 30-40, column 14 lines 45-55) comprising:

a) installing into a fire rated barrier 4 (a wall, see fig 1, abstract lines 1-11, column 1 lines 5-12, column 2 lines 40-46, column 3 lines 40-50, column 4 lines 30-40, column 14 lines 45-55) an electrical box 10 (see fig 1, column 2 lines 10-25, column 3 lines 40-45, column 4 lines 40-45, column 14 lines 38-55) , the electrical box 10 compromising the fire resistance of the fire rated barrier (see

Art Unit: 2831

column 1 lines 5-40, column 2 lines 1-28, column 3 lines 40-50, column 4 lines 30-45),

b) introducing into the electrical box 10 a fire retardant gasket 8 (a fire stopping mat, see fig 1, column 2 lines 10-64, column 3 lines 40-50, column 4 lines 30-45) of a fire resistant insulative material (i.e. a binder, see column 7 lines 57-67, column 9 lines 20-30, column 11 lines 24-67, column 12 lines 1- 24) containing **an intumescent graphite** (see abstract lines 11-14, column 9 lines 3- 30, please note that the fire stopping mat include an intumescent compound) ; and covering the electrical box 10 with a faceplate 6 (see fig 1, column 2 lines 1- 10, column 3 lines 40-45, column 4 lines 30-54, column 14 lines 40-55).

Regarding claim 38, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the fire retardant gasket 8 being adhered to the faceplate 6 prior to covering the electrical box 10 with the faceplate 6 (see column 2 lines 1-10, column 3 lines 40-50, column 14 lines 40-50, column 16 lines 10-18).

Regarding claim 40, the assembly of Dykhoff et al disclose all of the claimed features as shown above, including the fire retardant gasket 8 being introduced to the electrical box 10 without removing the electrical box 10 from the fire resistant barrier (see fig 1, column 2 lines 10-40, column 3 lines 30-50).

Art Unit: 2831

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 23-26 and 37-38,40 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Close Jr (4,163,137) in view of Landin (6,153,674).

Assembly of the device of Close comprises a method steps of:

Art Unit: 2831

Regarding claim 23, as best understood, a method of assisting a compromised barrier (a wall, see the entire column 3 and the entire column 4 and column 6 lines 5-10) comprising:

- a) providing a gasket 70, 70', 90 (see figs 2-5 and fig 7, column 1 lines 8-12, column 3 lines 40-60, column 4 lines 1-45) comprising fire retardant material of a fire resistant insulative material (**please note that the Close disclosed the gaskets 70' may be formed from a single sheet 98, and sheet 98 having fire retardant properties (see column 5 lines 15-45)** as well as the gasket may be vulcanized (see column 2 lines 1-5);
- b) placing the fire retardant gasket 70, 70' between a faceplate 50, 50' and an electrical box 28 (see figs 3 and 7, column 2 lines 1-5, and the entire column 3) adapted to be introduced into the barrier (see figs 3 and 7 and the entire column 3);
- c) coupling the faceplate 50, 50' to the box 28 (see figs 3 and 7 and the entire column 3 and the entire column 5) ; and d) at least partially reestablishing a fire rating of the barrier (see the entire column 3 and the entire column 6), but fails to disclose the fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite.

Landin teaches the use of a fire barrier material being especially useful in providing fire protection for electrical system (see column 1 lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see

Art Unit: 2831

column 3 lines 29-67, column 4 lines 1-38) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) or intumescent graphite (see column 1 lines 10-15, column 7 lines 15-30), in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses (see column 10 lines 50-62).

It is well known in the electrical art to use a fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite as evidence by **Landian**. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the fire retardant material of the gasket of the assembly of Close with a fire resistant insulative material containing mineral wool or intumescent graphite as taught by Landin in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses , and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its

Art Unit: 2831

suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 24 , as best understood, the modified assembly of Close disclose all of the claimed features as shown above, including coupling the gasket 70, 70' (see figs 3 and 7 of Close) in situ between the faceplate 50, 50' and the box 28 (see figs 3 and 7 of Close). *column 2 lines 1-5*

Regarding claim 25 , as best understood, the modified assembly of Close disclose all of the claimed features as shown above, including the gasket 70, 70' comprises forming the gasket 70, 70' as a separate element (see fig of Close) prior to placing the gasket 70, 70' between the faceplate 50,50' and the box 28 (see figs 3-4 and 7, column 2 lines 1-5 of Close).

Regarding claim 26 , as best understood, the modified assembly of Close disclose all of the claimed features as shown above, including forming the gasket 70, 70' on one surface of the faceplate 50,50' prior to coupling the faceplate 50, 50' to the box 28 (see figs 3 and 7, column 2 lines 1-5 of Close).

Close disclose:

Assembly of the device of Close comprises the method steps of:

Regarding claim 37, a method for assisting a compromised barrier

(a wall, see the entire column 3 and the entire column 4 and column 6 lines 5-10) comprising:

Art Unit: 2831

a) installing into a fire rated barrier (a wall, see the entire column 3 and the entire column 4 and column 6 lines 5-10) an electrical box 28 (see figs 3,7 and the entire column 3) , the electrical box 28 compromising the fire resistance of the fire rated barrier (see the entire specification),

b) introducing into the electrical box 28 a fire retardant gasket 70, 70', 90 ((see figs 2-5 and fig 7, column 1 lines 8-12, column 3 lines 40-60, and the entire column 5); and covering the electrical box 28 with a faceplate 50, 50' (see figs 3,7 and the entire column 3 and the column 6), but fails to disclose the fire retardant gasket of a fire resistant insulative material containing mineral wool or intumescent graphite.

Landin teaches the use of a fire barrier material being especially useful in providing fire protection for electrical system (see column 1 lines 55-60) with a fire retardant material having a fire resistant insulative material (i.e. binders, see column 3 lines 29-67, column 4 lines 1-38) containing mineral wool (see column 1 lines 10-15, column 2 lines 8-18, column 3 line 1) or intumescent graphite (see column 1 lines 10-15, column 7 lines 15-30), in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors (see column 1 lines 10-15) as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses (see column 10 lines 50-62).

Art Unit: 2831

It is well known in the electrical art to use a fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite as evidenced by Landian. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the fire retardant material of the gasket of the assembly of Close with a fire resistant insulative material containing mineral wool or intumescent graphite as taught by Landin in order to reduce or eliminate the passage of smoke and flames through openings between walls and floors as well as absorb a significant magnitude of heat and prevent transfer of heat from a fire across the barrier for a significant period of time and continue to delay fire spread passively and to seal any opening which could admit fire, heat, or corrosive gasses, and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 38, the modified assembly of Close discloses all of the claimed features as shown above, including the fire retardant gasket being adhered to the faceplate prior to covering the electrical box 28 with the faceplate (see fig 3 and the entire specification of Close).

Regarding claim 40, the modified assembly of Close discloses all of the claimed features as shown above, including the fire retardant gasket being introduced to

Art Unit: 2831

the electrical box 28 without removing the electrical box from the fire resistant barrier (see fig 3, and the entire specification of close).

Response to Arguments

6. Applicants' arguments with respect to claims 23-27, 37-38, 40 have been considered but they are not persuasive. The applicant argues the following:

A) the examiner has maintained the rejection of claims 23-27, 37-38 and 40 under 35 USC 102(e) and the examiner's refusal to consider the previously filed Declaration is improper. ... The examiner has not provided, nor can he, any reason to rebut the evidence set forth in the Declaration. The rejection of the claims of Dykhoff should therefore be withdrawn.

With respect to argument **A**, the examiner respectfully traverse. It is unclear that how the applicant can state that the examiner has not provided, nor can he, any reason to rebut the evidence set forth in the Declaration, when the examiner has clearly detailed that the applicant has failed to provide the following (see item 2 of office action mailed on 9/22/04 as well as item 2 of this current office action) :

For claim 23: a method of assisting a compromised barrier comprising : placing the fire retardant gasket between a faceplate and an electrical box, coupling

Art Unit: 2831

the faceplate to the box, and at least partially reestablishing a fire rating of the barrier.

For claim 37, a method of assisting a compromised barrier comprising: installing into a fire rated barrier an electrical box, introducing into the electrical box a fire retardant gasket, and covering the electrical box with a faceplate .

It is noted that a declaration does not provide the claimed subject matter for claims 23 and 37. Exhibit A for E -mail and discussed about "gasket" for cover plates, but did not provide any information about a gasket comprising fire retardant material of a fire resistant insulative material containing mineral wool or intumescent graphite as claimed in claim 23 and 37, Exhibit B discussed about an electrical box only, but did not provide placing the fire retardant gasket between a faceplate and an electrical box for claim 23 .Exhibit C discussed about metal size only, and Exhibit D discussed about a plate , a box, hole and cold face, but did not provide claimed subject matter for claims 23 and 37, and Exhibit E testing of 1.5mm blazeseal electrical plate covers only. Exhibits A through E are insufficient to establish a conception of the invention prior to the effective date of the 6,521,834 reference.

Further, the DECLARATION under 37 CFR 1.131 filed dated 3/30/04 is insufficient to overcome the rejection of claims 23-27, 37-38, 40 based upon anticipated by Dykhoff et al reference as set forth in the current Office action as

Art Unit: 2831

mentioned above and in light of the above comments, the examiner respectfully submits that the rejection of claims 23-27 and 37-38 is proper and just.

B) Examiner's Rejection of the Claims Under the Second paragraph of 35 U. S.

C. 112.... The examiner has provided no support for his conclusion that the claims are indefinite.

With respect to argument **B**, the examiner respectfully traverse. It is unclear that how the applicant can state that the examiner has provided no support for his conclusion that the claims are indefinite, when the examiner has clearly detailed that " at least partially reestablishing a fire rating of the barrier"

is confusing and unclear in light of the specification. What is at least partially reestablishing a fire rating of the barrier?. Specifically, **35 U. S. C. 112 first paragraph states :**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skill in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Also, **the specification must disclosed the definition of at least partially reestablishing a fire rating of the barrier** in order for those skilled in the art to understand the scope of the **claim when the claim is rad in light of the rest of the specification**, further applicants' argues that barriers typically exhibit

Art Unit: 2831

maximum fire ratings of 1,2,3 or 4 hours and **the original specification does not disclosed** barriers typically exhibit maximum fire ratings of 1,2,3 or 4 hours, **therefore, the claimed terminology of " at least partially reestablishing a fire rating of the barrier is indefinite to those of skill in the art when the claim is read in light of the rest of the specification.**

C) Claim 37 of applicants specifically recites " introducing into the electrical box a fire retardant gasket". The gasket of close is not introduced into the electrical box.

With respect to argument C, the examiner respectfully traverse because the applicant drawings do not show introducing into the electrical box a fire retardant gasket and the specification disclosed that " the gasket 14 can be coupled to the faceplate and /or box in some manner, such as affixing the gasket to the faceplate and / or the face of the box by use of various adhesive, see page 6 lines 20-24). ^{of the specification}

D) the gasket of Close is not a fire resistant insulative material, but rather is a plastic material.

With respect to argument D, the examiner respectfully traverse because Close disclosed that all of the gaskets being formed of sponge rubber or other sponge, ^{of close} easily compressible material (see column 4 lines 38-41) as well as the gasket may be vulcanized , see column 2 lines 1-5. ^{of close}

E) it is unclear why one of skill in the art would substitute such intumescent material for the gasket of close.

Art Unit: 2831

With respect to argument **E**, the examiner respectfully traverse because Close disclosed that all of the gaskets being formed of sponge rubber or other spongy, easily compressible material and the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

F) The amendment to the claims in the response filed on September 7, 2004 did not necessitate the new grounds of rejection since the amendments merely narrowed the claims to read on "wool" and "intumescent graphit" as the fire resistant insulative material.

With respect to argument **F**, the examiner respectfully traverse because the amendment to independent claims 23 and 37 on December 12, 2003 does not have a fire resistant insulative material containing mineral wool, ceramic fiber or intumescent graphit. **This new matter was introduced on the amendment filled on 3/30/04 and 9/7/04 for independent claims 23 and 37** and the ceramic fiber was cancelled on the amendment filled on 9/7/04.

G) A Final rejection is improper.

With respect to argument **G**, the examiner respectfully traverse because the amendment to independent claims 23 and 37 on **December 12, 2003** does not

Art Unit: 2831

have a fire resistant insulative material containing mineral wool, ceramic fiber or intumescent graphit. **This new matter was introduced on the amendment filed on 3/30/04 for independent claims 23 and 37.** The claims 24-26 depend from claim 23 and claims 38, 40 depend from claim 37 and the depend claims 24-26 and 38, 40 have not been considered with respect to newly added limitations in claims 23 and 37, therefore, a final rejection was proper, however, this office action include one additional rejection and therefore, this action is now non-final.

With respect to applicants' arguments on page 7 in response to office action mailed on 9/22/04 that " In any event, applicants' claims have been amended to specifically recite only the fire resistant insulative material as intumescent graphite or mineral wool, and neither of these materials being disclosed in Dykhoff. Dykhoff therefore cannot anticipate the claimed invention of applicants . The examiner is respectfully disagrees because Dykhoff clearly disclosed that the gasket (fire stopping mat) may include an intumescent compound and the intumescent compounds include intumescent graphite (see the entire abstract and column 9 lines 3-30 of Dykhoff).

With respect to applicants' arguments on page 9 in response to office action mailed on 09/22/04 that " at least partially reestablishing a fire rating of the barrier." i.e. partially or fully reestablishing a fire rating of 1,2,3, or 4 hours, and " one of skill in the art would recognize that barriers typically exhibit maximum fire

Art Unit: 2831

ratings of 1,2,3 or 4 hours..... wether those skilled in the art would understand the scope of the claim when the claim is red in light of the rest of the specification". The examiner is respectfully disagrees because **the specification must disclosed the definition of at least partially reestablishing a fire rating of the barrier** in order for those skilled in the art to understand the scope of the claim when the claim is rad in light of the rest of the specification, further applicants' argues that barriers typically exhibit maximum fire ratings of 1,2,3 or 4 hours. **It is noted that the specification does not disclosed** barriers typically exhibit maximum fire ratings of 1,2,3 or 4 hours.

Contact information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is 571-272-1983. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 2831

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pairedirect.uspto.gov>.

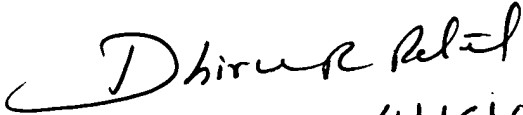
Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Dhiru Patel

Primary Examiner

Group Art Unit 2831

April 16, 2005


DHIRU R. PATEL
PRIMARY EXAMINER
4/16/05